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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hanna *et al.*

Appl. No. 09/030,832

Filed: February 26, 1998

For: **GABA_A Receptor Epsilon Subunits**



Art Unit: 1645

Examiner: Hayes, R.

Atty. Docket: 1488.0950001/EKS/KKV

Reply To Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **December 8, 1999**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group II, represented by claims 95-147. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

The Examiner has restricted the claims into the following groups:

- I. Claims 27-94 & 148-157, drawn to isolated nucleic acids that encode ET2 polypeptides, vectors and host cells comprising such, as well as methods of producing the polypeptide.
- II. Claims 95-147, drawn to isolated nucleic acids that encode GABRE polypeptides, vectors and host cells comprising such, as well as methods of producing the polypeptide.
- III. Claim 10, drawn to purified ET2 polypeptides.

Applicants respectfully traverse the restriction requirement. It is the Examiner's position that the three groups are directed to physically and functionally distinct products. Further, the Examiner stated that the "products can be prepared from different processes" and that the "polynucleotides of Group I are distinguished from the polynucleotides of Group II because they encode distinct proteins, as illustrated by their unique SEQ ID NOs" (Office action, pages 2 and 3). The Examiner further asserted that, due to the separate status in the art of the subject matter categorized into each group, the search and examination of the three groups together would constitute an undue burden.

The Examiner's basis for the restriction has been noted. However, even when patentably distinct inventions appear in a single application, restriction is improper unless the examiner can show that the search and examination of both groups would entail a "serious burden." *See* MPEP § 803. The Examiner has failed to make such a showing in the present instance.

Applicants submit that a search of the nucleic acid claims of Group I would clearly provide useful information for the polypeptide claim of Group III. This is because the genetic code is known. Moreover, in many, if not most, publications where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence. Thus, the searches for nucleic acid molecules and polypeptides encoded by these molecules would clearly be overlapping.

Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement as applied to Groups I and III.

Regarding the restriction between Groups I and II and II and III, Applicants assert that again, there is no serious burden for the Examiner to overcome in order to examine all three groups. The ET2 polypeptide and the GABRE polypeptide are related polypeptides. Thus, a

search of the elected Group II (directed to GABRE) would lend itself to a search of Group I and of Group III (for the reasons set forth above) (directed to ET2).

Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement as applied to Groups I and II and Groups II and III.

Regarding the processes of preparing the products, Applicants submit that the fact that the products can be prepared from different processes does not sufficiently distinguish the three groups. The products therein can be made by the same process as well. The hypothetical methods of producing the products, as posed by the examiner on pages 2-3 of the Office action, will not affect the search for the products themselves.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Kristin K. Vidovich

Kristin K. Vidovich
Attorney for Applicants
Registration No. 41,448

Date: Jan. 10, 2000
1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

ATTORNEYS AT LAW

1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON, D.C. 20005-3934

(202) 371-2600

FACSIMILE: (202) 371-2540; (202) 371-6566

ROBERT GREENE STERNE
EDWARD J. KESSLER
JORGE A. GOLDSTEIN
SAMUEL L. FOX
DAVID K.S. CORNWELL
ROBERT W. ESMOND
TRACY-GENE G. DURKIN
MICHELE A. CIMBALA
MICHAEL B. RAY
ROBERT E. SOKOHL
ERIC K. STEFFE
MICHAEL O. LEE

STEVEN R. LUDWIG
JOHN M. COVERT*
LINDA E. ALCORN
RAZ E. FLESHNER
ROBERT C. MILLONIG
MICHAEL V. MESSINGER
JUDITH U. KIM
TIMOTHY J. SHEA, JR.
DONALD R. MCPHAIL
PATRICK E. GARRETT
STEPHEN G. WHITESIDE
JEFFREY T. HELVEY*

HEIDI L. KRAUS
JEFFREY R. KURIN
RAYMOND MILLIEN
PATRICK D. O'BRIEN
LAWRENCE B. BUGAISKY
CRYSTAL D. SAYLES*
EDWARD W. YEE
ALBERT L. FERRO*
DONALD R. BANOWIT
PETER A. JACKMAN
MOLLY A. MCCALL

TERESA U. MEDLER
JEFFREY S. WEAVER
KRISTIN K. VIDOVICH
KENDRICK P. PATTERSON
DONALD J. FEATHERSTONE
GRANT E. REED
VINCENT L. CAPUANO
JOHN A. HARROUN*
MATTHEW M. CATLETT*
NATHAN K. KELLEY*
ALBERT J. FASULO II *

KAREN R. MARKOWICZ**
SUZANNE E. ZISKA**
BRIAN J. DEL BUONO**
ANDREA J. KAMAGE**
NANCY J. LEITH**
TARJA H. NAUKKARINEN**

*BAR OTHER THAN D.C.
**REGISTERED PATENT AGENTS

January 10, 2000



WRITER'S DIRECT NUMBER:
(202) 789-5519

INTERNET ADDRESS:
KVIDOVIC@SKGF.COM

Assistant Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Utility Patent Application
Appl. No. 09/030,832; Filed: February 26, 1998
For: **GABA_A Receptor Epsilon Subunits**
Inventors: Hanna *et al.*
Our Ref: 1488.0950001/EKS/KKV

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JAN 11 2000

TECH CENTER 1600/2900

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply To Restriction Requirement; and
2. One (1) Return Postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Assistant Commissioner for Patents
January 10, 2000
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Kristin K. Vidovich

Kristin K. Vidovich
Attorney for Applicants
Registration No. 41,448



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Enclosures

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